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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,889	10/01/2001	Manabu Deguchi	Q66258	3498

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EXAMINER

CHIANG, JACK

ART UNIT

PAPER NUMBER

2642

DATE MAILED: 05/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.	09/965889	Applicant(s)	M. Deguchi
Examiner	J. Chiang	Group Art Unit	2642
			#6

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

### Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### Status

- Responsive to communication(s) filed on 10-01-01.
- This action is FINAL.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- Claim(s) 14-20 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- Claim(s) \_\_\_\_\_ is/are allowed.
- Claim(s) 14-20 is/are rejected.
- Claim(s) \_\_\_\_\_ is/are objected to.
- Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All  Some\*  None of the CERTIFIED copies of the priority documents have been received.
- received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

### Attachment(s)

- Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_  Interview Summary, PTO-413
- Notice of References Cited, PTO-892  Notice of Informal Patent Application, PTO-152
- Notice of Draftsperson's Patent Drawing Review, PTO-948  Other \_\_\_\_\_

## Office Action Summary

**NOTE:** A preliminary amendment was submitted before the mailing of the first Office action dated on 03-15-04. Therefore, the first Office action is now vacated and replaced with the current Office action.

## CLAIMS

### **112 First Paragraph Rejection**

1. Claim 18 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

See comments below.

Claim 18 is also rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. See comments below.

In claim 14, it claims that a first key section including a selection key pad ... and an execution key.... It appears that it is claiming the first embodiment (fig. 1). In claim 18 which is depending from claim 1, it claims that the first key section consists of a single lever-type key. Claim 18 appears claiming the second embodiment (fig. 7). Once the first key section is defined to have a selection key pad and an execution key, it

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can no longer be a single lever-type key. Therefore, claim 18 is un-enabling and considered as a new matter.

### **Art Rejection**

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 20 is rejected under 35 U.S.C. 102(b or e) as being anticipated by Sudo et al. (US 5987336).

Regarding claim 20, Sudo shows:

Information items in rows and columns on a display (fig. 20);

A movement key and an execution key doubling as a calling key (col. 10, lines 43-53);

The steps of:

Moving a highlighted portion to a desired information item by operating the movement key (A-C in fig. 20);

Selecting the item to originate a call by operating the execution key (D-E in fig. 20, col. 10, lines 43-53).

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 14-17, 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wicks et al. (US 6128475) in view of Haas (EP 0602840) and Sudo et al. (US 5987336).

Regarding claims 14 and 20, Wicks shows a display (12) and a key operation section (14-15) comprising:

A first key section (15) including to select a desired item (moving a highlighted portion to a desired information item) (col. 3, lines 54-58), and to execute the item (selecting the desired item) (col. 3, lines 59-65); and

A second key section including a ten key pad (14).

Wicks differs from the claimed invention in that the first key section is a joy-stick key instead of a selection key pad and an execution key.

However, Haas teaches providing a joy-stick key (fig. 2) and its equivalent button key having an execution key surrounding by arrow keys (fig. 4). Further, from the present application (figs. 1 and 7), it also shows the two types of keys, and there is no teaching of criticality for one type over another.

Hence, it would have been obvious for one skilled in the art to use Wicks' joy-stick key as it is, or replace the joy-stick key with the button keys as taught by Hass. This simply can be considered as a variation of Wicks because the basic operation of the key is substantially unchanged.

Wicks further differs from the claimed invention in that it does not explicitly mention that the execution function has a calling function.

However, the concept of highlighting and executing the selected item is well taught by Wicks. It is also believed that Wicks' execution function has the calling function.

Further, this notorious well known phone operation is also taught by Sudo, in which it shows items are displayed in rows and columns, it also shows the highlighting and executing (calling) a selected phone number (col. 10, lines 43-53 in Sudo).

Hence, if it is found that Wicks' execution function does not have the calling function, then it would have been obvious for one of ordinary skill in the art to incorporate the calling function in Wicks' execution function with/without the teaching of Sudo, because in this phone environment, once a phone number was highlighted (col. 3, lines 54-58 in Wicks), the execution step has to be initiating the call according to the teaching of Wicks and Sudo.

Regarding claim 15-19, the combination of Wicks, Haas and Sudo shows:

A housing (fig. 1 in Wicks);

Movement operation keys and their contacts (402-405 in Haas) for selecting an item;

The enter key and its contact (406 in Haas) for executing the selected item;

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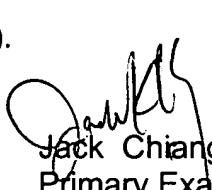
The single lever-type key (15 in Wicks) for selecting and executing the selecting item;

(NOTE: the present application and its claims involve potential restrictable issues, such as the type of keys in figs. 1 and 7, restriction might be issued depending on applicant's argument in the future).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack Chiang whose telephone number is 703-305-4728. The examiner can normally be reached on Mon.-Fri. from 8:00 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on 703-305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jack Chiang  
Primary Examiner  
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